

Application No.: 09/309,274

Docket No.: 00-VE09.46 RCE 1

REMARKS

Submitted herewith is the Declaration of Michael J. Strauss under 37 C.F.R. 1.131 ("Strauss Declaration") further evidencing that the invention of the subject matter of the rejected claims was conceived and reduced to practice prior to the February 8, 1999 effective date of Beith et al., U.S. Patent No. 6,449,496 ("Beith").

Applicant had previously submitted the Declaration of Alexander I. McAllister under C.F.R. 1.131 ("McAllister Declaration")¹. While the Examiner holds that the McAllister Declaration is ineffective to overcome Beith, reconsideration is respectfully requested in view of the submission of the Strauss Declaration and the remarks that follow.

According to the Examiner:

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Beith et al., reference. Inventor just states in the declaration paragraph #4 that "...my invention was made and tested...prior to February 8, 1999 is evidenced by the attached flowcharts (Exhibit A)..." However, submitted Exhibit A is basically a flowchart figure which neither proves reduction to practice nor the conception or diligence of the claimed invention. Furthermore, there is no evidence that Exhibit A existed before 02/08/99.

Office Action at page 2.

It appears from these remarks that the Examiner is improperly requiring documentary evidence in support of all statements made in the Declaration. There simply is no such requirement:

...in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. Ex parte Hook, 102 USPQ 130 (Bd. App. 1953).

MPEP §715.07 (emphasis added).

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37 C.F.R. §1.131 only requires that:

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

There is no requirement that all facts presented in the Declaration be proved by documentary evidence or other exhibits. The purpose of a declaration is to provide testamentary evidence by the declarant. For example, there simply is no requirement that the Inventor include exhibits proving that his activities occurred in the United States. The MPEP only requires that the declarant allege facts rather than conclusions:

715.07 Facts and Documentary Evidence

GENERAL REQUIREMENTS

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

- (A) attached sketches;
- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. *Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);*
- (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied

¹ The McAllister Declaration was erroneously captioned as pursuant to 37 C.F.R. 1.132 instead of 37 C.F.R. 1.131, the latter rather than the former addressing affidavits and declarations of prior invention to which the McAllister Declaration was substantively directed.

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on; examiners cannot be expected to search the entire interference record for the evidence. *Ex parte Homan*, 1905 C.D. 288 (Comm'r Pat. 1905);

(H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception.

Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d).

MPEP §715.07;

To the contrary:

The 37 CFR 1.131 affidavit or declaration must contain an **allegation** that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. See 35 U.S.C. 104.

MPEP §715.07(c) (emphasis added).

Applicant has complied with these requirements, stating that he had made an embodiment of the invention that operated as detailed in the flowchart figure:

The fact that my invention was made and tested in this country prior to February 8, 1999 is evidenced by the attached flowchart (Exhibit A) made by me prior to February 8, 1999, the flow chart depicting the operation of the BA Dialer system made by me and operational prior to the February 8, 1999 filing date of Beith.

McAllister Declaration at page 2.

Thus, the evidence that the invention was conceived and actually reduced to practice before 02/08/1999 must be acknowledged based on the declaration of the Inventor stating (alleging) that the invention was then in existence, the operation of the embodiment being detailed in the flowchart also having been made prior to that date. It was that flowchart that was subsequently included in the subject patent application as Figures 3a – 3d.

The Examiner further takes the position that “[e]ach and every claim submitted including dependents must be proved to have been reduced to practiced prior to any reference used.” Office Action at page 2. To the contrary, the MPEP definition of what must be shown does not require that all claims be addressed. The applicant need only show possession of the basic

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invention. As a logical premise, if a declaration is successful in antedating a reference resulting in the allowance of an independent claim, then it must follow that any and all claims dependent from that claim must likewise be allowable. There simply is no basis to require that applicant address each dependent claim.

The Examiner has taken the position that applicant has not proven either a constructive or actual reduction to practice. To the contrary, applicant has stated (alleged) in the McAllister Declaration that a working embodiment of the invention was fully operational prior to the filing date of Beith and, as evidence thereof, has submitted a copy of a flowchart that applicant represents was in existence prior to that date, the flowchart depicting the operation of the device as it existed no later than that date. That is proof of actual reduction to practice in accordance with Rule 131.

It is further clear that applicant HAS proven a constructive reduction to practice by filing the subject patent application. Even if there were not an operational embodiment of the invention (which there was), the flowchart, taken with applicant's statement, is clear evidence of conception of the invention prior to the February 8, 1999 filing date of Beith, culminating in filing the subject application on May 11, 1999 which is a constructive reduction to practice. In view of the above remarks with respect to the inherent allowability of dependent claims if their respective independent claims are allowable, it had been proven in the prior response that the filing of the subject application is a constructive reduction to practice, contrary to the Examiner's position (Office Action, page 3).

Furthermore, contrary to the Examiner's assertion, the flowchart taken with applicant's statement is persuasive evidence of prior conception of the invention (as well as actual reduction to practice). Applicant has not specifically addressed diligence in the McAllister Declaration since that issue is moot because the McAllister declaration proves an actual reduction to practice of the invention before the effective date of the reference, rather than conception alone. Thus, for the reasons presented above, the McAllister Declaration is considered to be more than sufficient to antedate Beith.

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Beith is further not available as a reference in view of the Strauss Declaration submitted herewith. As detailed therein, a disclosure meeting on which the subject application is based was conducted on September 2, 1998, well prior to the filing date of Beith. Provided to Michael J. Strauss at that time was the flowchart diagram previously submitted and which constitutes Figure 3a – 3d of the subject application. A patent search report was ordered thereafter, the search results becoming available on or about October 5, 1998. These results were made available to the applicant in a Patentability Investigation Report ("Report" in the Strauss Declaration) on or about December 18, 1998. That report stated that the BA Dialer had been developed and "is currently running on three platforms". This is clear evidence of actual reduction to practice. All of these activities, including work on preparation of the patent application, occurred well prior to the filing date of Beith. Thus, the Examiner now has even more FACTS evidencing that the subject invention was conceived and actually reduced to practice prior to the February 8, 1999 filing date of Beith. Further, although applicant can prove diligence from conception to actual reduction to practice, there is no need for applicant to establish diligence where there is an actual reduction to practice before the effective date of the reference, as here.

Applicant notes that the Report is an attorney-client privileged document. Only facts from that Report such as a date and operational status of an embodiment of the present invention (and not counsel advice) are being presented herein. Accordingly, such privilege has not been waived and is not jeopardized. Applicant expressly reserves its rights in such privileged document including, but not limited to, the right to assert such privilege to prevent and/or limit disclosure of the document and its contents.

In view of the above and either or both of the McAllister and Strauss Declarations, Beith is demonstrated to not be available as a reference and each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

If any additional fees are due in connection with the subject application, including any extension of time fees, please charge our Deposit Account No. 07-2347 from which the undersigned is authorized to draw.

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Respectfully submitted,

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